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In the United States Patent and Trademark Office

#12
11/24/03
A.V.

In re the Application of:

William Hsiao-Yü Ku)
Serial No. 09/734,805)
Filed: 12/11/2000)
Docket: AUS9-2000-0768-US1)
For: "Search Facilities for Local and)
Remote Interface Repositories")

Group: 2175

Examiner: Samuel G. Rimell

RESPONSE TO ADVISORY ACTION and RESPONSE TO MISCELLANEOUS COMMUNICATION

Assistant Commissioner for Patents
Washington, DC 20231

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Sir:

Responsive to the Examiner's Advisory Action mailed on October 8, 2003, and to a subsequently mailed Examiner's Miscellaneous Communication mailed on October 23, 2003, please receive our reply.

Respectfully Submitted,

Robert H. Frantz, Agent for the Applicant

Reg. No. 42,553

Franklin Gray Patents, LLC
P.O. Box 23324
Oklahoma City, OK 73127
Tel: 405-812-5613
Fax: 405-440-2465

Response to Advisory Action

Examiner mailed an Advisory Action on October 8, 2003, in which it was stated that the amendment filed by applicant on September 25, 2003, would not be entered because (a) it failed to place the application in a condition for allowance, and (b) it raised new issues requiring further consideration. This amendment was filed concurrent with a Notice of Appeal in response to examiner's Final Rejection of all claims of this patent application. No further reasons or details were provided by the examiner as to why or how this amendment raises new issues requiring further consideration.

Applicant respectfully traverses examiner's decision not to enter the amendment. This amendment simply deletes a double word error ("protocol protocol") in Claim 1 which was the subject of the examiners §112 rejection in the previous Office Action, and adopts the examiner's suggestion to amend the claim to delete one of the instances of the word protocol.

Examiner's Office Action dated 8/12/2003 rejected Claims 1 - 13 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. As for rationale, examiner only provided details of the rejection of Claim 1, upon which claims 2 - 13 depend, stating:

"In line 3, the word 'protocol' is repeated, rendering the claim slightly confusing. This can be readily corrected by deleting the second instance of 'protocol'".

Title 37 C.F.R. §1.116(b) states (emphasis added):

§ 1.116 Amendments after final action or appeal.

(b) After a final rejection or other final action (§ 1.113) in an application or in an ex parte reexamination filed under § 1.510, or an action closing prosecution (§ 1.949) in an inter partes reexamination filed under § 1.913, **amendments may be made** canceling claims or **complying with any requirement of form expressly set forth in a previous Office action. Amendments presenting rejected claims in better form for consideration on appeal may be admitted.** The admission of, or refusal to admit, any amendment after a final rejection, a final action, an

action closing prosecution, or any related proceedings will not operate to relieve the application or patent under reexamination from its condition as subject to appeal or to save the application from abandonment under § 1.135, or the reexamination from termination. No amendment can be made in an inter partes reexamination proceeding after the right of appeal notice under § 1.953 except as provided for in paragraph (d) of this section.

Further, MPEP 706.07(e) states (emphasis added):

... Further amendment or argument will be considered in certain instances. An amendment that will place the application either in condition for allowance or in better form for appeal may be admitted. Also, amendments complying with objections or requirements as to form are to be permitted after final action in accordance with 37 CFR 1.116(a).

In our amendment, we requested deletion of the *first* instance of the word ‘protocol’:

... through Object Request Broker ~~protocol~~ (ORB) protocol ...

Our amendment to Claim 1 deletes the first instance of the word ‘protocol’ as it does not properly belong as part of an acronym for Object Request Broker or ‘ORB’. In other words, the widely accepted expansion of the acronym ORB is not “Object Request Broker protocol” but is just “Object Request Broker”. Therefore, it is least confusing to provide the acronym immediately following the words which it abbreviates.

Applicant hereby requests reconsideration of the decision to deny entry of the amendment on the following grounds:

- (a) the amendment is submitted in order to place the claims in better condition for consideration during appeal as allowed by 37 C.F.R. §1.116(b);
- (b) the amendment is submitted in order to comply with an examiner’s requirement as to form expressly set forth in a previous Office Action as allowed by 37 C.F.R. §1.116(b);

- (c) entry of the amendment is allowed by policy of the Office as stated in MPEP 706.07(e) because it places the claims in better condition for consideration during appeal;
- (d) entry of the amendment is allowed by policy of the Office as stated in MPEP 706.07(e) because it complies with an examiner's requirement as to form; and
- (e) there are no other outstanding reasons or bases for rejection of these claims under 35 U.S.C. §112, second paragraph, provided in either the first Office Action on the merits on 2/24/2003 or in the final Office Action on 8/11/2003.

If examiner maintains the decision to deny entry of this amendment, then please consider the present applicant's reply as a part of applicant's Appeal Brief addressing the improper final rejection of Claims 1 - 13 under 35 U.S.C. §112, second paragraph, for the following reasons:

- (a) the existence of the double word error is deemed to be only "slightly confusing" as stated by the examiner in his rejection;
- (b) an obvious double-word error is a typographical error, which is a matter of form not substance, to which a rejection is a requirement as to form; and
- (c) denial of entry of an amendment after final rejection in order to comply with a requirement of form expressly made by the examiner in a previous Office Action, or in order to place the claims in better condition for consideration during appeal is against Patent Office policy and counter to the provides of Title 37 Code of Federal Regulations.

Response to Examiner's Miscellaneous Communication

Examiner mailed a "Miscellaneous Communication" to applicant on 10/23/2003 in which it was noted that applicant's Appeal Brief had been received on October 2, 2003, but that no Notice of Appeal had been previously received. Examiner notified applicant that if a Notice of Appeal has been previously filed, a copy of the previously filed Notice of Appeal, including evidence of filing, may be used, instead of re-submitting both the Appeal Brief and Notice of Appeal.

Applicant filed a Notice of Appeal by facsimile on September 25, 2003, under a Certificate of Transmission under 37 C.F.R. §1.8, including a Notice of Appeal transmittal, PTO form SB/31, which includes authorization to charge the Notice of Appeal fee under 37 C.F.R. §1.17(b) to applicant's Deposit Account, copies of which, including the facsimile transmission confirmation sheets from our facsimile machine and from the Patent Office's RightFax server, are attached (stamped with red ink "COPY").

Additionally, we have checked the status of this application via the Patent Office's Patent Application Information Retrieval ("PAIR") system, and noticed that the Notice of Appeal was subsequently entered into the file as number #24, and afforded a receipt date of September 25, 2003. A copy of the PAIR screen printout from November 11, 2003, is also attached herewith.

Conclusion

As previously stated, we hereby request reconsideration and entry of the minor amendment to Claim 1, as well as allowing this application to proceed into the Appeals process as all necessary papers and fees have been timely filed, as evidenced herein.

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TO: Examiner Samuel G. Rimell
U.S. Patent and Trademark Office
GAU 2175
Tel: 703-306-5626
Fax: 703-746-7238 After Final

FROM: Robert H. Frantz
Franklin Gray Patents, LLC
Tel: 405-812-5613
Fax: 405-440-2465

DATE: September 25, 2003

PAGES: 3 (inclusive)

In re the Application of:

William Hsiao-Yu Ku)
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Remote Interface Repositories")

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Examiner: Samuel G. Rimell

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ROBERT H. FRANTZ, REGISTERED US PATENT AGENT

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TO: Examiner Samuel G. Rimell
U.S. Patent and Trademark Office
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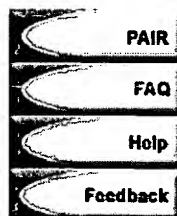
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DATE: September 25, 2003					
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In re the Application of: William Hsiao-Yu Ku Serial No. <u>09/734,805</u> Filed: 12/11/2000 Docket: <u>AUS-2000-0768-US1</u> For: "Search Facilities for Local and Remote Interface Repositories"			Group: 2175 Examiner: Samuel G. Rimell		
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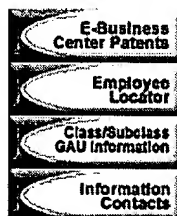
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PATENT APPLICATION INFORMATION RETRIEVAL



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Search results for application number:09/734,805			
Application Number:	09/734,805	Customer Number:	-
Filing or 371(c) Date:	12-11-2000	Status:	Notice of Appeal Filed
Application Type:	Utility	Status Date:	11-03-2003
Examiner Name:	RIMELL, SAMUEL G	Location:	-
Group Art Unit:	2175	Location Date:	11-03-2003
Confirmation Number:	2052	Earliest Publication No:	US 2002-0073078 A1
Attorney Docket Number:	AUS9-2000-0768-US1	Earliest Publication Date:	06-13-2002
Class/ Sub-Class:	707/003	Patent Number:	-
First Named Inventor:	William Ku, Austin, TX	Issue Date of Patent:	-
Title Of Invention:	Search facility for local and remote interface repositories		

Continuity Data

Published Documents

File Contents History		
Number	Date	Contents Description
24	09-25-2003	Notice of Appeal Filed
23	10-23-2003	Mail Miscellaneous Communication to Applicant
22	10-22-2003	Miscellaneous Communication to Applicant - No Action Count
21	10-08-2003	Mail Advisory Action (PTOL - 303)
20	10-07-2003	Advisory Action (PTOL-303)
19	10-02-2003	Date Forwarded to Examiner
18	09-25-2003	Amendment after Final Rejection

17	08-12-2003	Mail Final Rejection (PTOL - 326)
16	08-11-2003	Final Rejection
15	05-30-2003	Date Forwarded to Examiner
14	05-23-2003	Response after Non-Final Action
13	05-27-2003	Mail Examiner Interview Summary (PTOL - 413)
12	05-23-2003	Examiner Interview Summary Record (PTOL - 413)
11	02-27-2003	Mail Non-Final Rejection
10	02-24-2003	Non-Final Rejection
9	08-09-2002	Case Docketed to Examiner in GAU
8	01-28-2002	Case Docketed to Examiner in GAU
7	12-03-2001	Case Docketed to Examiner in GAU
6	12-11-2000	Information Disclosure Statement (IDS) Filed
5	05-26-2001	Case Docketed to Examiner in GAU
4	01-30-2001	Application Dispatched from OIPE
3	01-26-2001	Correspondence Address Change
2	01-10-2001	IFW Scan & PACR Auto Security Review
1	12-11-2000	Initial Exam Team nn

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